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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,967	01/22/2004	Gary Martin Zelman	4078	7898

7590 06/14/2004

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EXAMINER	
MAI, HUY KIM	

ART UNIT	PAPER NUMBER
2873	

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,967	ZELMAN, GARY MARTIN	
	Examiner	Art Unit	
	Huy K. Mai	2873	

-- The MAILING DATE of this communication app ars on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Oath/Declaration

1. The declaration filed on Jan. 22, 2004 is acceptable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The method claim as claimed in the independent claim 1 does not include the steps to perform the function in the method claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al (6,012,811).

Chao et al discloses, in Fig. 16, column 8, lines 7-31, an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses comprising mounting means 360 mounting a magnet on said conventional eyeglasses; mounting means 354 mounting a magnet 358 on said auxiliary eyeglasses for mating beneath said magnet on said conventional eyeglasses. Chao et al also

suggests in column 8, lines 14-15 that "Note that the (magnet (emphasized)) members 356 and 358, each can further include more than one portion" and "In yet another embodiment, the bridge 360 of the primary frame also includes its magnetic member, disposed at a location with correct polarity with respect to the magnetic member of the auxiliary frame". Therefore it would have been obvious at the time the invention was made to a person having skilled in this art to modify the Chao et al's apparatus by forming a plurality of magnets 358 on the mounting means 354 and a plurality of corresponding magnets on the mounting means 360 of the primary eyeglasses as suggest by Chao et al. Such a modification would not change the scope of the invention in the Chao et al reference.

6. Regarding method claim 1, the apparatus including means for performing the functions, as claimed in the method claims, is unpatentable over Chao et al, as discussed above. It would have been obvious at the time the method is made to a person having skill in this art to recognize the steps in the Chao et al modified apparatus to perform the functions for attaching auxiliary eyeglasses to conventional eyeglasses as the applicant claimed in claim 1.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-3,6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,550,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention as claimed in claims 1-3,6-8 is substantially the same as that in claims 1-6 of the '913 patent. All elements claimed in claims 1-3,6-8 in the present patent application are included in claims 1-6 of the '913 patent. These elements in the present application perform the same function as those of the elements in claims 1-6 of the '913 patent. Thus, the invention claimed in claims 1-3,6-8 is substantially identical to that in claims 1-6 of the '913 patent.

9. Claims 1-3,6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,705,722. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention as claimed in claims 1-3,6-8 is substantially the same as that in claims 1-14 of the '722 patent. All elements claimed in claims 1-3,6-8 in the present patent application are included in claims 1-14 of the '722 patent. These elements in the present application perform the same function as those of the elements in claims 1-14 of the '722 patent. Thus, the invention claimed in claims 1-3,6-8 is substantially identical to that in claims 1-14 of the '722 patent.

10. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,139,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

claimed invention as claimed in claims 1-14 is substantially the same as that in claims 1-8 of the '142 patent. All elements claimed in claims 1-14 in the present patent application are included in claims 1-8 of the '142 patent. These elements in the present application perform the same function as those of the elements in claims 1-8 of the '142 patent. Thus, the invention claimed in claims 1-14 is substantially identical to that in claims 1-8 of the '142 patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

Huy Mai
Primary Examiner
Art Unit 2873

HKM/
June 9, 2004